

## **REMARKS**

### **A. Status of the Claims**

Claims 1-46 were examined and rejected over U.S. Patent No. 4,425,908 to Simon (Simon). These claims have been canceled, and new claims 47-59 have been added. These new claims are directed to methods, and are patentably distinct from Simon. They are also patentably distinct from U.S. Patent Nos. 5,261,916 ('916 Patent) and 5,304,195 ('195 Patent), both of which are filed in a corresponding Supplemental Information Disclosure Statement. Upon entry of the requested amendments, claims 47-59 will be pending.

### **B. Examiner Interview**

Applicant notes with appreciation Examiner Truong's courteous personal interview with Applicant's representative George Gerstman on February 10, 2004. The examined claims and certain proposed new claims were discussed. Examiner Truong suggested that Applicant reduce the number of pending claims, and further suggested that Applicant consider prosecuting method claims.

### **C. Examined Claims 1-46 Were Patentable Over Simon**

The Office rejected claims 1-46 as being anticipated by Simon. While these claims have been canceled, and the rejection of them is therefore moot, Applicant does not acquiesce to the Office's position for the following reasons.

Claims 1-40 and 42-46 were all directed to some type of intravascular device that included a lead element that was either capable of causing, or structured to cause, occlusion of a vessel. Simon does not teach or suggest such a lead element. Additionally, in certain of those claims, the claimed trailing and leading elements were detachably interconnected. Simon fails to disclose or suggest a

detachable interconnection between what the Office construed to be Simon's lead and trailing elements. For at least these reasons, claims 1-40 and 44-46 were patentable over Simon.

Claim 41 was directed to a method that included providing a detachment apparatus and attaching the trailing element of the claimed intravascular device to the detachment apparatus. Simon fails to teach or suggest such a detachment apparatus. Thus, for at least this reason, claim 41 was patentable over Simon.

#### **D. The New Claims Are Patentable and Should Be Allowed**

##### **1. Claims 47 and 48**

Claim 47 is directed to a method for producing occlusion of a vessel or an aneurysm. The method includes, in relevant part, providing an intravascular device having a lead element, and a trailing element connected by a non-metallic member to the lead element. Claims 47 and 48 are entitled to the September 2, 1992 filing date accorded to Serial No. 07/939,296.

Simon fails to teach or suggest using a non-metallic member to connect coils 12 and 14. Instead, Simon teaches making the wires around which those coils are wrapped from a material with thermal and shape memory properties. See, e.g., col. 5, lines 26-40. Furthermore, neither the '916 nor '195 Patents teach or suggest a non-metallic member connecting a trailing element to a lead element.

For at least these reasons, claims 47 and 48 are patentable and should be allowed.

##### **2. Claims 49-51**

Claim 49 is directed to a method for producing occlusion of a vessel or an aneurysm. The method includes, in relevant part, providing an intravascular device having a lead element, and a non-spherical trailing element connected to the lead element; providing a detachment apparatus engaging the non-spherical trailing element of the intravascular device; and disengaging the

intravascular device from the detachment apparatus. Claims 49-51 are entitled to the September 2, 1992 filing date accorded to Serial No. 07/939,296.

The '916 and '195 Patents fail to teach or suggest a non-spherical trailing element. Simon fails to teach or suggest a detachment apparatus that engages the non-spherical trailing element, or disengaging an intravascular device from a detachment apparatus.

For at least these reasons, claims 49-51 are patentable and should be allowed.

### **3. Claims 52 and 53**

Claim 52 is directed to a method for producing occlusion of a vessel or an aneurysm. The method includes, in relevant part, providing an intravascular device having a bioactive lead element, and a trailing element connected to the lead element. Claims 52 and 53 are entitled to the December 9, 1993 filing date accorded to Serial No. 08/164,398.

Simon, the '916 Patent and the '195 Patent all fail to teach or suggest an intravascular device that has a bioactive lead element. For at least this reason, claims 52 and 53 are patentable and should be allowed.

### **4. Claims 54-56**

Claim 54 is directed to a method for producing occlusion of a vessel or an aneurysm. The method includes, in relevant part, providing an intravascular device having a lead element, and a trailing element comprising a coil connected to the lead element; providing a detachment apparatus engaging the trailing element of the intravascular device; and disengaging the intravascular device from the detachment apparatus. Claims 54-56 are entitled to the September 2, 1992 filing date accorded to Serial No. 07/939,296.

Simon fails to teach or suggest a detachment apparatus that engages the trailing element, or disengaging an intravascular device from a detachment apparatus. The '916 and '195 Patents both

fail to teach or suggest an intravascular device that has a lead element and a trailing element connected to the lead element that comprises a coil. The '916 and '195 Patents teach using coils for the lead elements, but do not teach or suggest trailing elements that comprise a coil.

For at least these reasons, claims 54-56 are patentable and should be allowed.

#### **5. Claims 57-59**

Claim 57 is directed to a method for producing occlusion of a vessel or an aneurysm. The method includes, in relevant part, providing an intravascular device having a lead element, and a trailing element connected to the lead element, the trailing element being configured to anchor the intravascular device within the vessel or aneurysm; providing a detachment apparatus engaging the trailing element of the intravascular device; and disengaging the intravascular device from the detachment apparatus. Claims 57-59 are entitled to the September 2, 1992 filing date accorded to Serial No. 07/939,296.

Simon fails to teach or suggest a detachment apparatus that engages the trailing element, or disengaging an intravascular device from a detachment apparatus. The '916 and '195 Patents fail to teach or suggest a trailing element that is configured to anchor the intravascular device within a vessel or aneurysm. Instead, the trailing elements in those patents are simply balls that are not configured to serve any anchoring function.

For at least these reasons, claims 57-59 are patentable and should be allowed.

#### **E. Petition for Extension of Time**

Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of two months up to and including March 6, 2004 in which to respond to the Office Action dated October 6, 2003. The Commissioner is authorized to deduct the extension of time fee for a large entity should the check be missing, any extra claims fees (at the large entity rate), and any other

fees required for any reason relating to the enclosed materials under 37 C.F.R. §§ 1.16 to 1.21, from Fulbright & Jaworski Deposit Account No.: 50-1212/UTSD:533USR1/MTG.

**F. Conclusion**

Applicant has severely limited the number of claims pursuant to the Examiner's suggestion during the interview. Applicant believes that these amendments and remarks fully respond to all outstanding matters for this application, and Applicant respectfully requests that the Office allow new claims 47-59. Should Examiner Truong desire to discuss this application in more detail by telephone, or if any additional concerns remain, he is requested to contact Applicant's representative George Gerstman at (312) 269-8567 or by e-mail at *ggerstman@seyfarth.com*. Alternatively, the undersigned attorney may be reached at (512) 536-3031 or by e-mail at *mgarrett@fulbright.com*.

Respectfully submitted,



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